

REMARKS

This communication responds to the Final Office Action (*Office Action*) mailed on August 27, 2009. Claims 1, 42, and 43 have been amended. Claims 2, 3, 8, and 22-41 were previously canceled. No additional claims have been canceled and no claims have been added. As a result, claims 1, 4-7, 9-21, and 42-43 remain pending in this application.

Rejection of the Claims under 35 U.S.C. §102(e)

On page 2, paragraph 3 of the *Office Action*, the Examiner rejected claims 1, 4, 5, 7, 9-21, 42, and 43 under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Patent Application No. 2003/0135421 to *Cales et al. (Cales)*. Since a *prima facie* case of anticipation has not been properly established, Applicant respectfully traverses the rejection.

In order to anticipate a claim, a reference must teach all limitations, arranged or combined in the same way as recited in Applicant's claim. The Court of Appeals for the Federal Circuit recently held

[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also ***all of the limitations arranged or combined in the same way as recited in the claim***, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.¹

Because *Cales* fails to disclose all limitations of independent claims 1, 42, and 43, these claims are not anticipated, and are thus novel.

Applicant has amended independent claim 1. Amended claim 1 recites, *inter alia*, “subsequent to the determining that the seller is eligible to offer the buyer the money-back guarantee, ***contacting the seller to provide the seller an option to offer the buyer the money-back guarantee.***”² Support for this amendment can be found in at least, for example, paragraph [0063] of the originally filed application. Each of Applicant's other independent claims, namely claims 42 and 43, share at least limitations similar to those of claim 1 recited, above.

¹ *Net MoneyIn, Inc. v. Verisign, Inc.*, No. 2007-1565 at 17. (Fed. Cir. Oct. 20, 2008); emphasis added.

² Emphasis added.

Applicant respectfully submits that *Cales* does not disclose each and every element of Applicant's claims, and particularly, *Cales* does not disclose each element as arranged in the claims. In particular, *Cales* does not disclose at least "subsequent to the determining that the seller is eligible to offer the buyer the money-back guarantee, ***contacting the seller to provide the seller an option to offer the buyer the money-back guarantee***" as recited in amended claim 1.

In contrast to Applicant's claims, *Cales* merely discusses a "third party buyer protection service (BPS) to monitor and direct a business transaction between a buyer and seller. The BPS is configured to affect a refund to the buyer when . . . the buyer decides to return the product."³

To utilize the BPS, the buyer and seller must first agree to the terms and policies of the service. The process proceeds with receipt of the buyer E-mail with account registration, all necessary transaction information and a buyer payment issued to the BPS. The buyer payment includes the product purchase price, applicable tax and the buyer protection service fee. The service monitors and directs the transaction and, most importantly, holds the buyer payment for distribution to the buyer or seller dependent on direction from the buyer. This inventive solution guards the buyer against losing the payment due to seller fraud or product mismanagement.⁴

In *Cales*, after the parties agree to utilize the BPS, "the buyer emails the BPS to set up an account followed by the transaction information . . . Alternatively, the private seller may supply the transaction information."⁵ Thus, *Cales* fails to anticipate Applicant's claimed element of "subsequent to the determining that the seller is eligible to offer the buyer the money-back guarantee, ***contacting the seller to provide the seller an option to offer the buyer the money-back guarantee***" as recited in amended claim 1. In *Cales*, the BPS does not contact the seller to provide the seller an option to provide the money-back guarantee after determining the seller is eligible to offer it. Instead, the buyer contacts the BPS to set up an account and either the buyer or seller supplies the BPS the transaction information. Thus, the BPS is passive and does not contact the seller to provide the seller an option to offer the buyer the money-back guarantee.

³ Cales at para. [0011].

⁴ *Id.*

⁵ Cales at [0031] and [0037]; *also see* FIG. 4A, step 404.

Since Applicant has shown that not all the claimed elements were known as required by the *Net MoneyIn* court, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §102(e) with regard to independent claims 1, 42, and 43. Further, since claims 4, 5, 7, and 9-21 depend, either directly or indirectly from claim 1, they too are allowable for at least the same reasons as the independent claims from which they depend. Further these dependent claims each may contain additional patentable subject matter.

Rejection of the Claims under 35 U.S.C. §103(a)

On page 6, paragraph 4 of the *Office Action*, the Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Cales* in view of U.S. Published Patent Application No. 2004/0172260 to Junger et al. (*Junger*).

However, claim 6 depends from independent claim 1 and includes all limitations therein. Consequently, claim 6 is allowable for at least the same reasons as given with reference to claim 1, above. As discussed above, *Cales* does not disclose at least Applicant's claimed element of "subsequent to the determining that the seller is eligible to offer the buyer the money-back guarantee, contacting the seller to provide the seller an option to offer the buyer the money-back guarantee." Applicant submits that *Junger* too fails to teach or suggest this limitation. Further, claim 6 may contain additional patentable subject matter. Applicant respectfully requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §103 with regard to dependent claim 6.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned representative at (408) 660-2015 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402--0938
(408) 660-2015

Date 12/28/2009

By



Bradley W. Scheer
Reg. No. 47,059

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 28 day of December, 2009.

Dawn R. Shaw

Name

/Dawn R. Shaw/

Signature